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The BOC Group, Inc.
Legal Services - Intellectual Property
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Murray Hill NJ 07974

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DEC 30 2004

OFFICE OF PETITIONS

In re Application of :
Michael Ernest Garrett :
Application No. 10/699,131 : DECISION REFUSING STATUS
Filed: October 31, 2003 : UNDER 37 CFR 1.47(b)
Attorney Docket No. 98B112 (CIP2) :

This is in response to the petition under 37 CFR 1.47(b), filed August 30, 2004. Applicant obtained a five-month extension of time to reply. Accordingly, the petition is filed timely.

The petition is dismissed.

Applicant is given TWO MONTHS from the mailing date of this decision to respond, correcting the below-noted deficiencies. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)" and may include an oath or declaration executed by the inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

On October 31, 2003, applicant filed the above-identified application without an executed oath or declaration. On February 2, 2004, the Office of Initial Patent Examination mailed a Notice to File Missing Parts of Nonprovisional Application requiring an executed oath or declaration and surcharge.

In response, applicant filed the present petition, a request for a five-month extension to reply, a declaration for utility when using an ADS, and paid the necessary fees. The declaration lists the inventor's name and citizenship without a signature.

In the present petition, Philip H. Von Neida, attorney for applicant, states that on February 5, 2004, Ms. Betty Lee sent a declaration, power of attorney and assignment forms to Mike Wickham, Associate Counsel at The BOC Group, via inter-office

mail for him to forward them to the nonsigning inventor, Michael Garrett. On March 30, 2004, Mr. Wickham emailed Ms. Lee indicating that Mr. Garrett had suffered a stroke and lost the ability to write. On May 26, 2004, Ms. Lee was informed by Mr. Wickham that Mr. Garrett will not be signing the declaration. In response, on May 27, 2004, Ms. Lee emailed Mr. Wickham requesting the name and residence of Mr. Garrett's legal representative, but no response was received. A copy of the email correspondence accompanies the petition.

A grantable petition under 37 CFR 1.47(b) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration; (2) an acceptable oath or declaration; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor; (5) proof of proprietary interest; and (6) proof of irreparable damage. Applicant lacks item (1), (2), (4), (5) and (6) set forth above.

As to item (1), applicant failed to show or provide proof that the inventor has refused to sign the declaration. Before an inventor can refuse to sign an oath or declaration, he must have been presented with a copy of the application papers, including the specification, claims and drawings. Applicant showed that Ms. Lee sent the application papers to Mr. Wickham for him to forward them to the nonsigning inventor. However, there is no statement or documentary evidence showing that a copy of the application papers was presented to the inventor. Additionally, it is unclear from the petition whether Mr. Garrett has refused to sign the declaration or is incapable of signing the declaration. If Mr. Garrett is refusing to sign the declaration after receiving a complete copy of the application papers, applicant must submit proof of the pertinent events in a statement of someone with first hand knowledge of the events.

However, if Mr. Garrett is legally incapacitated, applicant must present a copy of the complete application papers to his legal representative (guardian, conservator, etc.), who may sign the declaration.

As to item (2), applicant has not submitted a declaration for the patent application in compliance with 37 CFR 1.63 and 1.64. The Office notes that pursuant to Section 409.03(b) (A) of the Manual for Patent Examining Procedure:

Where a corporation is the 37 CFR 1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer or Chief Executive Officer) thereof should normally sign the

necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or, the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation. Where the oath or declaration is being signed on behalf of an assignee, see MPEP Section 324. An inventor may not authorize another individual to act as his or her agent to sign the application oath or declaration on his or her behalf. *Staeger v. Commissioner*, 189 USPQ 272 (D.D.C. 1976), *In re Striker*, 182 USPQ 507 (Comm'r Pat. 1973). Where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b).

If the Mr. Garrett is refusing to sign the declaration, applicant should have the declaration signed by an officer of the corporation such as the President, Vice-President, Secretary, Treasurer or Chief Executive Officer on behalf of the nonsigning inventor. The declaration should set forth the name of the person executing the declaration and his title or position as indicated above and leaving Mr. Garrett's signature block blank.

If Mr. Garrett is legally incapacitated, applicant must set forth the name, residence, post office address, and citizenship of the legal representative. The declaration should be signed by the legal representative on behalf of Mr. Garrett, leaving Mr. Garrett's signature block blank.

As to item (4), a statement of the inventor's last known address is missing and is required.

As to item (5), applicant failed to show or provide proof that The BOC Group has sufficient proprietary interest in the subject matter to justify the filing of the application (see MPEP 409.03(f)). Acceptable proof would include a copy of the employment agreement between the non-signing inventor and The BOC Group, a copy of an assignment agreement showing that the invention disclosed in the application is assigned to The BOC Group, or a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent

jurisdiction would by the weight of authority in that jurisdiction award the title of the invention to The BOC Group.

As to item (6), applicant failed to provide proof of irreparable damage (see MPEP 409.03(g)). A statement by applicant that the filing is necessary to preserve the rights of the parties would be sufficient.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 220 20th Street S.
 Customer Window, Mail Stop Petition
 Crystal Plaza Two, Lobby, Room 1B03
 Arlington, VA 22202

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
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Office of Petitions